

Docket No. 99B065-2

REMARKS

Claims 1-36 are pending in the present application. Claims 5, 6, 13, and 14 have been cancelled. New claims 37- 58 have been added.

The office action summary sheet provided by the PTO lists claims 1-36 as pending and claims 1-36 as rejected. Applicant however is able to identify only rejections for claims 1-2, 7-10, 15, 18, and 36. Thus claims 3-6, 11-14, 16, 17, and 19-35 are either not rejected or have been rejected without any explanation. Applicant requests clarification from the Examiner. In addition, Applicant respectfully requests that the finality of the office action be withdrawn in light of the absence of any written rejection for claims 3-6, 11-14, 16, 17, and 19-35.

Claim Rejections Under 35 U.S.C. § 112

The Examiner states that "[t]he rejection of claims 1-2 has been maintained due to the failure to modify in the amendment." Applicant is unsure of what the Examiner means. Modify what? And how? Clarification is requested from the Examiner.

Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 7-10, 15, 18, and 36 are stand rejected under 35 U.S.C. § 112, first paragraph. The Examiner suggests that "...the specification, while being enabling for THF and methyl tert-butyl ether..., does not reasonably provide enablement for all the ethers."

Claims 7-10, 15 and 18 do not particularly address ethers. Claims 7-10 address temperature and pressure ranges. Claims 15 and 18 address additional steps in the production process. Why in particular does the Examiner suggest these particular claims are not enabled for all the ethers? Applicant respectfully requests clarification from the Examiner.

In any event, the Examiner has acknowledged that Applicants have provided 22 examples to support enablement. The Examiner has provided no objective evidence or scientific basis to support the putative assertion that one of ordinary skill in the art could not practice the invention without undue experimentation. The standard of uncertainty regarding enablement, as described in MPEP §2164.04, has not been met.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-2, 7-10, 15, 18, and 36 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner submits for the first time that the phrase "contacting an olefin or ether" is unspecific and complicated. Applicant respectfully disagrees and submits the phrase is clear and simple to one of ordinary skill in the art. However solely to accommodate the Examiner's request, Applicant has made the suggested style changes. Two sets of claims are now present. One set directed to olefin based processes and the other to ether based processes. These changes are not intended to alter the scope of claim coverage in any way. Applicants submit that these amendments to Claim 1 moot this rejection and respectfully request reconsideration and withdrawal of the rejection.

Furthermore this rejection is new and has not been previously presented in any office action. The office action states that applicant's amendments necessitated the new grounds of rejection and thus makes the action is final. This statement is incorrect. The new grounds of rejection relate to the phrase "contacting an olefin or ether" which has been present in claim 1 from the beginning. The amendment to claim 1 made in Applicant's June 2003 response inserted a specific list of alcohols into claim 1. This amendment does not relate in any way to the phrase "contacting an olefin or ether. Hence the amendment did not necessitate the new rejection. Applicant respectfully requests that the finality of the rejection be withdrawn.

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CONCLUSION

Applicants submit that the claims are in condition for allowance.
Reconsideration and allowance is respectfully requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 05-1712 maintained by Assignee.

Respectfully submitted,

11-13-03
Date

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